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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,993	01/12/2001	Richard B. Greenwald	213.1079-CIP3	9994

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EXAMINER

RUSSEL, JEFFREY E

ART UNIT	PAPER NUMBER
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1654

17

DATE MAILED: 05/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/758,993

Applicant(s)

GREENWALD ET AL.

Examiner

Jeffrey E. Russel

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1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31 is/are allowed.
- 6) ☒ Claim(s) 1-16, 18-30, and 32-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The marked-up copy of amended claim 32, last two lines, does not correspond with the clean copy of amended claim 32, last line. Any future amendments should be carefully checked to ensure accurate markings of all amendments made to the claims.
2. Claims 1-16, 18-30, and 32-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 36, and 37, are indefinite because in the last two lines of each claim, the claim does not indicate what membrane $Z[D]_y$ is capable of crossing. [It should be noted that this limitation did not need to be included in new claims 36 and 37, because these claims are based upon originally-presented claims 9 and 14 which were not rejected over the Zier et al article.] Claim 18 is dependent upon canceled claim 17. Claim 32 is indefinite because the last line of the claim indicates that Z is always covalently linked to the at least one biologically active material, whereas it is only after the reaction that Z becomes covalently linked to the at least one biologically active material. Claim 37 is indefinite because of the contradiction in the definitions of L_1 and Y_3 occurring at lines 4-5. If $L_1-C(Y_3)$ comprises an amino acid residue, then L_1 can not be a bifunctional linking moiety in general, and Y_3 can not be S or NR_{12} as defined below in the claim.
3. Claims 2, 7, and 31 are objected to because of the following informalities: Appropriate correction is required. At claim 2, line 3, the comma which was originally present between the first and second structures has been omitted. In claim 7, the SEQ ID NO was inserted before the tripeptide rather than after the tetrapeptide which is subject to the sequence disclosure rules. At claim 31, line 6, the underlining was left in below the semicolon that was inserted at the end of the line.

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4. Claims 9 and 36 are identical in scope. Upon an indication of allowability, one of the claims will be objected over the other consistent with the procedures of MPEP § 706.03(k). It is recommended that in the response to this Office action, Applicants amend or cancel one of these two claims in order to avoid this objection. Applicants should also ensure that claims 14 and 37 do not become identical in scope after any amendment of claim 37 in response to this Office action.

5. Applicant's amendments and arguments filed March 11, 2003 have been fully considered and are persuasive. Therefore, the objections and rejections set forth in the first Office action are withdrawn. However, new grounds of rejection and objection are made above in view of the amendments to the claims.

6. Claim 31 is allowed. Claims 1-16, 18-30, and 32-37 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

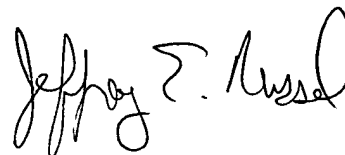
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (703) 308-3975. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Brenda Brumback can be reached at (703) 306-3220. The fax number for Art Unit 1654 for formal communications is (703) 305-3014; for informal communications such as proposed amendments, the fax number (703) 746-5175 can be used. The telephone number for the Technology Center 1 receptionist is (703) 308-0196.



Jeffrey E. Russel

Primary Patent Examiner

Art Unit 1654

JRussel

May 29, 2003